

REMARKS

Prior to entry of this paper, Claims 1-29 were pending. Claims 1-29 were rejected. No amendments are made in this paper. Claims 1-29 are currently pending. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

Claims 9-12 and 15

Claims 9-12 and 15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Harms et al. (US Publish 2003/0078981, hereinafter referred as Harms). Each of these rejections is respectfully traversed.

The rejection to Claim 9 is respectfully traversed at least because Harms fails to disclose, “accessing, over a network, an electronic archive comprising a list of e-mail addresses generated with a first application”, as recited in Applicants’ Claim 9.

The Office Action states that this limitation is met in Harms by “monitor incoming message or scan message database, incoming message is received ‘over a network’ and generated by sender application, Figures 3, paragraph [0031].” It is respectfully submitted that these actions of Harm fail to meet the limitation of Harms discussed above. “Monitoring incoming email message” is not accessing an electronic archive comprising a list of emails. Rather, it is receiving an email message sent to a user, which is much different that accessing an electronic archive comprising a list or e-mail addresses.

Scanning the user database, on the other hand, does qualify as accessing an electronic archive comprising a list of e-mails, but fails to meet other parts of the limitation, including “over a network”. In Harms, the user database on the portable device may be scanned to retrieve email addresses, but this database is the not accessed “over a network” by the portable device; rather, the database is on the portable device itself, and is therefore not accessed over a network.

The Office Action states, “Second, Harms discloses receiving incoming message through a network (Figure 1, network 110, paragraph [0014]). Therefore, Harms teaches ‘accessing, over a

network, an electronic archive comprising a list of e-mail address generated with a first application””. However, it is respectfully submitted that Harms only accesses the email received in this case, not an electronic archive comprising a list of e-mail addresses. The server sending the email might have an electronic archive, but if so, Harms does not have access to that electronic archive; Harms only accesses the received email.

The Office Action also stated, “Third, Harms discloses a method and apparatus ‘message in a database or storage device are scanned and reviewed’ (paragraph [0029], lines 3-4). Harms also discloses that device 100 communicates with network 110. Using network to access the database is inherent in the prior art. Person with ordinary skill in the art will know how to use network to access database in a server or other computers in the network. Therefore, ‘over a network’ is inherently taught in the prior art, the claims limitations are based on the inherent function.” However, it is respectfully submitted that the issue is not whether the portable device of Harms communicates over a network, but whether or not the portable device of Harms accesses the database over a network. The database is contained in the portable device of Harms; the portable device does not access the database “over a network”.

Claim 9 is respectfully submitted to be allowable for at least the reasons stated above. Claim 10-12 and 15 are respectfully submitted to be allowable at least because they depend from Claim 9.

Claims 21-27

Claims 21-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tafoya et al. (US Patent 6,952,805, hereinafter referred as Tafoya). Each of these rejections is respectfully traversed.

Claim 21 is respectfully traversed at least because Tafoya fails to disclose, “adding the e-mail address to the electronic address book”, as recited in Applicants’ Claim 21. Additionally, as an independent reason for traversing the claim, Claim 21 is respectfully traversed at least because Tafoya fails to disclose, “providing to a user device, over the network, an access to the electronic address book”, as recited in Applicants’ Claim 21.

The email resolution list of Tafoya is not an electronic address book. The email resolution list of Tafoya is an email resolution list which is distinct from an electronic address book. As is known in the art, an electronic address book allows a user to select an address book entry from a list, and does not require part of the email address to be entered before an entry is selected.

In fact, the Tafoya reference itself specifically distinguishes email resolution from address books, for example, at Col. 1, line 48 through Col. 2, line 2. In this section, Tafoya discusses the desirability of email resolution that is **not dependent** on the address book.

Claim 21 is respectfully submitted to be allowable for at least the reasons stated above. Claims 22-27 are respectfully submitted to be allowable at least because they depend from Claim 21.

Additionally, the rejection to Claim 22 respectfully traversed for at least the following additional reasons. It is respectfully submitted that Tafoya fails to disclose, “adding the e-mail address to the electronic address book further comprises adding the e-mail address if the e-mail address occurs at a certain frequency, the e-mail address is similar to another e-mail address, or a date associated with the e-mail address meets a threshold”, as recited in Applicants’ Claim 22.

For example, Tafoya discusses at Col. 12, lines 20-30 that send/receive usage, send frequency, and receive frequency may be used to assign a weight to each entry in the resolution list (based on an equation shown in box 422 of FIG. 4B of Tafoya).

In one embodiment of the Applicants’ invention, a user may select a number N, and any email address with a frequency less than N is automatically excluded from the address book, or select a date in which emails not appearing after that date are automatically excluded from the address book.

In contrast, with Tafoya, frequency is a factor that is weighted, but Tafoya fails to disclose a particular minimum frequency for which it is guaranteed that the email will not be included. Rather, in Tafoya, frequency is one factor that weighted.

Additionally, Claim 25 is respectfully traversed for at least the following additional reasons. Tafoya fails to disclose, “sending a parsing instruction to cause remote parsing of the e-mail on a network device which stores the plurality of archives of e-mails”, as recited in Applicants’ Claim 25. The Office Action states that this limitation is met in Tafoya by accessing the data store to

extract email addresses. However, it is respectfully submitted that Tafoya fails to meet the limitation because the data store is local, not remote, and therefore remote parsing of the email is not performed in Tafoya.

Claims 28-29

Claims 28-29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Creswell et al. (US Patent 6,564,264, hereinafter referred to as Creswell). Each of these rejections is respectfully traversed.

The rejection to Claim 28 is respectfully traversed at least because Creswell fails to disclose, “accessing a first source electronic address book for a first e-mail address” in conjunction with the limitation, “adding the e-mail address to the destination electronic address book if the first defined criterion is satisfied”, as recited in Applicants’ Claim 28.

Creswell describes updating a user's address book. In Creswell, the **destination** is an address book in this case, but the **source** is not an electronic address book. The Office Action refers to "access address book for 'send to' address, Figure 3, item 303, column 4, lines 44-47." It is respectfully submitted that it is unclear what Office Action is referring to here by accessing "address book for 'send to' address". Creswell certainly does not access the address book of the sender of the email! This would be a serious violation of the sender's privacy, assuming it were even possible! It is unlikely that this is what the Office Action means then, but it is unclear what it does mean; Creswell does not disclose accessing "address book for 'send to' address".

Creswell only involves one address book, the user's address book, as opposed to a source electronic address book and a destination electronic address book as recited in Applicants' Claim 28.

Claim 28 is respectfully submitted to be allowable at least for at least the reasons stated above. Claim 29 is respectfully submitted to be allowable at least because it depends from Claim 28.

Claims 1-6, 7, 8, 13, 14, and 16-20

Claims 1-6, 8, 13 and 16-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harms in view of Tafoya. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harms and Tafoya as applied to claim 1, and further in view of Creswell. Claim 14 was rejected under 35 U.S.C.(a) as being unpatentable over Harms as applied to claim 12, and further in view of Cortright et al. (US Patent 6,895,426, hereinafter referred as Cortright). Each of the rejections is respectfully traversed.

It is respectfully submitted that the proposed combination of Harms and Tafoya would not have been obvious at the time the invention was made, and that the combination is based on impermissible hindsight.

Tafoya describes a system and method for populating a dynamic email resolution list. It is respectfully submitted that it would not have occurred to one of ordinary skill in the art at the time the invention was made to use the system and method of Tafoya to populate an electronic **address book**.

Tafoya states, at Col. 1, line 61 through Col. 2, line 2:

“However, many email users do not take the time to enter friendly name information into their email address books. Thus, these systems are limited by the users willingness to update and fully complete his/her email address book. Therefore, what is needed is an email system that not only utilizes email users' entries, but also other known information that is not dependent on the entries to automatically resolve email addresses.”

To solve this problem, Tafoya proposes a system and method of automatically populating a dynamic email **resolution list**; while **not changing the user's electronic address book**. With the benefit of hindsight granted by knowledge of the Applicants' invention, we see another possible solution: Tafoya could have possibly used a similar system and method to automatically update the user's electronic address book, instead of the email resolution list. This solution, however, is only evident with the benefit of impermissible hindsight.

The Tafoya reference is a Microsoft patent. Microsoft is a sophisticated company, with many well-known email-related products and services, such as Hotmail, Outlook Express, and

Microsoft Outlook. It seems likely that if using the system and method of Tafoya to populate an electronic address book rather than the email resolution list would have been obvious to the inventors or to Microsoft, it would have at least been mentioned in the Tafoya patent. Further, it seems **unlikely** that if the idea of using the system and method of Tafoya to populate an electronic address book rather than an email resolution list did not occur to the inventors or to Microsoft at the time, that it would have been obvious to one of ordinary skill in the art at the time the invention was made without the use of impermissible hindsight.

Further, Tafoya teaches away from the proposed combination. Tafoya specifically teaches that what is needed is an email system that provides an email resolution employing the method as taught in Tafoya in such a way that the email resolution is not dependent on the user's address book. This teaches away from the Office Action's proposed modification in which the method of Tafoya is used changed the user's address book instead of the email resolution list.

For at least these reasons, it is respectfully submitted that Claims 1-6, 8, 13, and 16-20 are in condition for allowance, and notice to that effect is earnestly solicited. Claim 13 is also respectfully submitted to be allowable at least because it depends from Claim 9. Claim 7 is respectfully submitted to be allowable at least because it depends from Claim 1. Claim 14 is respectfully submitted to be allowable at least because it depends from Claim 9.

With regard to Claims 5 and 14 the rejection is respectfully traversed for at least the following additional reasons.

The rejection to Claim 5 is also respectfully traversed at least because the proposed combination fails to meet the further limitations of Claim 5 considered as a whole. Claim 5 recites, "determining if the at least one archive from which the e-mail address was retrieved includes an organization; organizing the electronic address book according to at least a portion of the at least one archive from which the e-mail address was retrieved; and the adding includes adding the e-mail such that the e-mail address is added according to the organized address book". The Office Action states that the limitation "determining if the at least one archive from which the e-mail address was retrieved includes an organization" is met in Harms by the fact that the archive is a database. The Office Action states that the limitation, "determining if the at least one archive from which the e-mail address was retrieved includes an organization; organizing the electronic address book

according to at least a portion of the at least one archive from which the e-mail address was retrieved” is met in Harms based on organization by last name in Figure 4 of Harms.

First, the fact that the names in Figure 4 of Harms are listed in alphabetic order may have been coincidental, as the natural order occurring in the mind the drafter of the Harms document, rather than organization performed by the method of Harms. Even if the method of Harms does perform an alphabetizing step that is not mentioned in the patent, this is independent of the organization of the source. For example, Harms does not disclose, determining whether the database is alphabetized, and if so, alphabetizing the destination list accordingly. Rather, the alphabetizing step performed in Harms, if there is one, is independent of any organization that exists in the source. Applicants' Claim 5 requires a determination whether the source archive includes an organization, and if so, organizing the electronic address book in accordance with the organization of the source. In one embodiment of Applicants' invention, the determination of organization is a determination of whether the source is organized by folder, although the invention is not so limited. Organization by alphabetizing is included within the scope of Claim 5. However, Harms does not disclose a step of determining whether the source archive is alphabetized. The proposed combination fails to meet the limitations of Applicants' Claim 5.

The rejection to Claim 14 is also traversed at least because the proposed combination fails to meet any of the limitations recited in Applicants' Claim 14.

The Office Action states that Harms discloses “determining if the archive includes an organizational folder (database, paragraph [0025], lines 8-9).” However, a database is not a folder. A database may be included within a folder, but a database itself it not a folder.

The Office Action further states that Harms discloses “the adding includes adding the first e-mail address to the electronic address book in the generated folder (Figure 4, paragraph [0027]). However, neither Figure 4 nor paragraph [0027] of Harms involves a folder in an electronic address book.

The Office Action further states that Cortright discloses, “determining if the e-mail address was retrieved from the organization folder (provide an icon to identify whether the e-mail address was retrieved; person, list, newsgroup, test, or address. Figures 4A/B, 5A/B, Figure 9, column 4, lines 44-67, column 8, lines 1-43).” However, none of this has anything to do with a folder of an

address book. The Office Action further states, “Cortright also discloses generated a folder within the address book and add e-mail address to the folder (column 10, lines 26-44, lines 55-61).” However, nothing in column 10 of Cortright has anything to do with address book folders.

CONCLUSION

It is respectfully submitted that each of the presently pending claims (Claims 1-29) are in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicants reserve the right to raise these arguments in the future.

Dated: September 25, 2006

Respectfully submitted,

By_

Matthew M. Gaffney

Registration No.: 46,717

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(206) 262-8900

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant